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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/839,424

04/20/2001

David L. Brown

3364/1 (PHA 4176)

1761

7590

07/30/2002

Pharmacia Corporation  
Corporate Patent Department  
P.O. Box 5110  
Chicago, IL 60680-9889

EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/839,424

Applicant(s)

BROWN ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-113 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

The examiner notes that during a telephone conversation with Patricia Fitzsimmons on 1/13/02, that a provisional election was made with traverse to prosecute the invention of example 1 on page 157. The examiner notes that since there has been a change in restriction/election policy at the office, that the examiner must also apply a restriction requirement to the claims. The applicant has is asked to elect a species that falls into one of the restricted groups below. The examiner notes that the applicant elected the species of example 1 on page 157, but in light of the new restriction requirement, the applicant is given an opportunity to make a fresh election of species if it is different from example 1 on page 157 and election of a group. If the election of species of example 1 on page 157 is maintained, then this election falls into group I and group I will be examined.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 11-16, 31, 32, 35, 36, 37, 38, 40, 41, 92, 94, 99, 101, 105-113, drawn to the compound of formula I where A is thiophene, R1 is phenyl or cyclohexyl optionally substituted with the groups claimed, R2 is as claimed, R3 is all the moieties except those containing a heterocyclyl ring, method of treating and a pharmaceutical composition, classified in class 549, subclass 61.
- II. Claims 1-17, 92, 93, 99, 100, 105-113, drawn to the compound of formula I where A is pyrazolyis, R1 is cyclohexyl or phenyl optionally substituted

as claimed, R2 is as claimed, R3 is all moieties except those containing heterocyclic moieties, method of treating and a pharmaceutical composition, classified in class 548, subclass 367.4.

- III. Claims 42-54, 95, 99, 102, 105-113, drawn to the compound of formula I where A is isoxazole, R1 is cyclohexyl, phenyl, optionally substituted as claimed, R2 is as claimed, R3 is all moieties except those containing a heterocyclic moiety, a method of treating, and a pharmaceutical composition, classified in class 548, subclass 243.
- IV. Claims 55-67, 96, 99, 103, 105-113, drawn to the compound of formula I where A is furanone, R1 is cyclohexyl or phenyl optionally substituted as claimed, R2 is as claimed, R3 is all moieties except those containing heterocyclic moieties, a method of treating, and a pharmaceutical composition, classified in class 549, subclass 318.
- V. Claims 68-79, 97, 99, 104-113, drawn to the compound of formula I where A is cyclohexene, R1 is cyclohexyl or phenyl optionally substituted as claimed, R2 is as claimed, R3 is all moieties except those containing heterocyclic moieties, method of treating and a pharmaceutical composition classified in class 514, subclass 646.
- VI. Claims 68-79, 97, 99, 104-113, drawn to the compound of formula I where A is pyridine, R1 is cyclohexyl or phenyl optionally substituted as claimed, R2 is as claimed, R3 is all moieties except those containing heterocyclic

moieties, method of treating and a pharmaceutical composition, classified in class 546 subclass 302.

The inventions are distinct, each from the other because of the following reasons:

In the instant case the different inventions have achieved a separate status in the art, have separate fields that aren't coextensive, and are capable of supporting separate patents. Further, a prior art reference that would anticipate the claims under 35 USC 102(b) would not render obvious the same claim(s) under 35 U. S. C. 103 (a) with respect to another member. Searching the entire genus would be a burden on the USPTO in terms of time and expense.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claim 1-113 are generic to a plurality of disclosed patentably distinct species comprising Am R1-R3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Patricia Fitzsimmons on 1/13/02 a provisional election was made with traverse to prosecute the invention of example 1 on page 157. The examiner notes that the applicant elected the species of example 1 on page 157, but in light of the new restriction requirement, the applicant is given an opportunity to make a fresh election of species if it is different from example 1 on page 157 and election of a group. If the election of species of example 1 on page 157 is maintained, then this election falls into group I and group I will be examined and claims 9-10, 17-30, 33-34, 39, 42-93, 95-100, 102-104 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

A telephone call was made to Patricia Fitzsimmons on 7/25/02 to request a new oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson

July 28, 2002



**ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**